

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Mobilogic, Inc.  
v.  
Netcore Technology, Inc.

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Opposition No. 100,989  
to application Serial No. 74/613,435  
filed on December 20, 1994

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Penny R. Slicer, Andrea K. Falk and Joseph A. Mahoney of  
Stinson Mag & Fizzell, P.C. for Mobilogic, Inc.

Martin Korn of Locke Purnell Rain Harrell for Netcore  
Technology, Inc.

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Before Hanak, Wendel and Bucher, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Netcore Technology, Inc., a Texas corporation, has  
filed an application for registration of the mark "PAGE  
RUNNER" for "computer software to facilitate communication  
of paging messages between a sender and a receiver."<sup>1</sup>

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<sup>1</sup> Serial No. 74/613,435, in International Class 9, filed  
December 20, 1994, based upon an allegation of a *bona fide*  
intention to use the mark in commerce. On May 5, 1995, an  
amendment to allege use under 37 C.F.R. 2.76 was filed with the

Mobilogic, Inc., a Kansas Corporation, filed a timely notice of opposition on February 22, 1996. As grounds for opposition, opposer asserts prior use of the trademark "PAGERUNNER" for computer software to facilitate communication of paging messages between a sender and a receiver. Opposer asserts that these marks are identical and that the goods are most similar in function, and for purposes of trademark law, are considered identical. As a result, opposer alleges that applicant's mark, as applied to applicant's goods, so resembles opposer's mark as to be likely to cause confusion within the meaning of Section 2(d) of the Lanham Act.

Applicant, in its answer, has admitted that it filed the instant application under the intent-to-use provisions of the Trademark Act, but has otherwise denied the salient allegations of the opposition.

A trial was conducted and legal briefs have been filed, but neither party requested an oral hearing.

In evidence are the pleadings; the file of the opposed application; a copy of applicant's responses to opposer's first set of interrogatories introduced by opposer under a notice of reliance pursuant to 37 C.F.R. 2.120(j); and the deposition transcript of Susan Sarno, vice president and

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Office, alleging use on January 4, 1995 and use in interstate commerce on January 7, 1995.

partial owner of opposer, along with nineteen deposition exhibits.

The marks herein are substantially identical -- "PAGE RUNNER" (having a space in mark as presented on applicant's drawing page) and "PAGERUNNER" (without a space whenever mark appears in typed form in the opposition record, from the time of the Notice of Opposition through final reply brief)<sup>2</sup> -- and the goods are recited as being identical. Interestingly, applicant in its brief does not even address the issue of likelihood of confusion, so this case turns solely on the question of priority of use.

Applicant takes the position that opposer has not shown actual use in commerce prior to applicant's constructive use date or its actual date of first use in commerce. Specifically, applicant argues that opposer's reliance on an advertising brochure mailed to hundreds of prospective buyers is insufficient to show use of the mark in commerce under Section 45 of the Trademark Act. Secondly, applicant charges that the mark was not properly used in conjunction with the software in an alleged sale to a specific customer

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<sup>2</sup> In the reality of the marketplace, both parties present their marks in ways that create an identical commercial impression, i.e., as a single, run-together word but creating separation with an upper-case (or larger) letter "P" and upper-case (or larger) letter "R" (viz., PageRunner or PAGERUNNER). Applicant has created additional separation (not suggested in its typed drawing or specimens of record) by used contrasting colors (i.e., the word "Page" being in red or burgundy and the word "Runner" being in black or blue). See deposition exhibits 17 and 19 accompanying deposition transcript of Susan Sarno.

in Monroe, Louisiana, Mr. Randy Gilley of Gilley's Heating and Cooling. Hence, we turn to the evidence of record to determine if opposer has sufficiently proven prior use in commerce.

According to uncontested testimony, during the summer of 1994, opposer developed a new software product to facilitate paging messages, and adopted the coined name "PAGERUNNER" for this new product.<sup>3</sup> Opposer completed the first commercial installation of its "PAGERUNNER" software in July 1994.<sup>4</sup> It continued to demonstrate, promote, market, sell, and deliver its "PAGERUNNER" software to potential customers and resellers that fall.<sup>5</sup> On October 15, 1994, opposer mailed hundreds of brochures with a letter and order form.<sup>6</sup> Contrary to applicant's assertions, this mailing solicited orders and touted a special introductory, limited-time price of \$995.<sup>00</sup>, expiring on December 31, 1994.<sup>7</sup> Between October and December 1994, opposer followed up these letters with telephone calls to most of the five hundred companies who had been sent the brochures.<sup>8</sup> On October 31, 1994, opposer sent the same brochure and order

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<sup>3</sup> Deposition transcript of Susan Sarno, p. 12.

<sup>4</sup> Deposition transcript of Susan Sarno, p. 16.

<sup>5</sup> Deposition transcript of Susan Sarno, p. 16.

<sup>6</sup> Deposition transcript of Susan Sarno, p. 17.

<sup>7</sup> Deposition transcript of Susan Sarno, pp. 17 - 19.

<sup>8</sup> Deposition transcript of Susan Sarno, p. 20.

form to thirty resellers of such products.<sup>9</sup> Documents from mid-November 1994 include an airbill reflecting the shipment via Federal Express of a package to Randy Gilley. The record reflects a later charge of \$999.<sup>95</sup> (\$995.<sup>00</sup> for the software plus \$4.<sup>95</sup> for shipping and handling) to Randy Gilley's VISA credit card.<sup>10</sup> Over the next six-weeks, this sale was followed by at least five other documented sales of the software directly to specific end-users and many more units sold to resellers.<sup>11</sup>

We turn first to an examination of the letter, sales brochure, and order form sent to five hundred potential customers in mid-October 1994.<sup>12</sup> The record contains exhibits showing that on October 13, 1994, Modern Business Systems of Jefferson City, MO, printed up five-hundred letters on Mobilogic letterhead and five-hundred color copies of the PageRunner solicitation having an order form printed on the back thereof.<sup>13</sup> The letter is dated October 14, 1994, and a packet of envelopes marked "return-to-sender" (i.e., undeliverable solicitations sent to some of

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<sup>9</sup> Deposition transcript of Susan Sarno, pp. 20 - 21.

<sup>10</sup> Deposition transcript of Susan Sarno, pp. 25 - 28, and deposition exhibits 8, 9 and 10.

<sup>11</sup> Deposition transcript of Susan Sarno, pp. 30 - 41, and deposition exhibits 13, 14, 15 and 16.

<sup>12</sup> Deposition exhibit 4 accompanying deposition transcript of Susan Sarno.

<sup>13</sup> *Id.*

these potential customers) show the same post-mark, namely, "Shawnee Mission, Kansas, October 15, 1994."<sup>14</sup>

We find that these solicitations were certainly more than mere advertising. *cf.* *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997). Whether these two-sided, color papers qualify as a "display associated" with goods is a factual question. Accordingly, we find that, like the use of a mark in a mail order catalog, this is a point of sale display associated with the goods, constituting valid trademark usage. See *Lands' End Inc. v. Manbeck*, 24 USPQ2d 1314 (DC E.Va. 1992). As the court noted in the *Lands' End* case, *supra*, "A customer can identify a listing and make a decision to purchase by filling out the sales form and sending it in or by calling in a purchase by phone." We find the facts of this case to be totally analogous. The discussion in the *Lands' End* case about "pictures" of the purse featured in the mail-order catalogue are understandable given the importance to the mail-order purchaser of the visual appeal of this particular accessory, and the fact that the purse was only one of several items featured on that same page of the Lands' End catalogue. Where, as is the case herein, the goods themselves are floppy diskettes, and the solicitation is for a single item,

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<sup>14</sup> Deposition exhibit 6 accompanying deposition transcript of Susan Sarno.

the absence of a picture of a diskette on this flier, for example, is meaningless.

Most importantly, the back of this flier is an order form. A customer who received this solicitation/brochure could fill out this half-page order form, indicating the preferred media specification of the diskette and charging the purchase to a credit card, before faxing or mailing the order to opposer. Accordingly, we find that as of mid-October 1994, opposer's hundreds of solicitations constituted valid trademark usage of its mark.

Finally, as to the usage during the fall 1994 of the trademark on the actual computer software (i.e., diskettes distributed to the ultimate users as well as those marketed to customers through resellers), we do have copies of computer screen prints which show the mark prominently displayed on several successive screens, as well as on the labels affixed to the diskettes themselves.<sup>15</sup> Diskette labels are routinely submitted to the Patent and Trademark Office as trademark specimens for software in International Class 9. Furthermore, screen prints are also consistent with Office practice during the *ex parte* examination of specimens for computer program. See TMEP 905.04(d) -

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<sup>15</sup> Deposition transcript of Susan Sarno, pp. 13 - 14, and deposition exhibit 3.

"Specimens for Trademarks Identifying Computer Programs, Movies or Video Tapes."<sup>16</sup>

Decision: Inasmuch as there is clearly a likelihood of confusion herein, and opposer has established priority of usage, this opposition is sustained.

E. W. Hanak

H. R. Wendel

D. E. Bucher

Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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The computer program, video tape and movie industries have adopted the practice of applying trademarks to their goods in such a manner that the marks are visible only when the programs or movies are displayed on a screen (perhaps, for example, on the first several frames of a movie).

A photograph of a display screen projecting the identifying trademark of a computer program or a photograph of a frame or frames of a movie or video tape bearing the mark sought to be registered should be acceptable as evidence of trademark use. It is not a prerequisite to acceptability of specimens that purchasers be able to see the mark prior to purchase of the goods. *In re Brown Jordan Co.*, 219 USPQ 375 (TTAB 1983) (stamping the mark after purchase of the goods, on a tag attached to the goods, which thereafter are transported in commerce, held sufficient).